

REMARKS

In response to the Office Action dated May 26, 2005, Applicants respectfully request reconsideration based on the above claim amendments and the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance.

Claims 1-5, 7-13, 15 and 16 are pending in the present Application. Claims 1 and 7 are amended and Claim 4 is canceled, leaving Claims 1-3, 5, 7-13, 15 and 16 for consideration upon entry of the present amendments and following remarks.

Support for the claim amendments can at least be found in the specification, the figures, and the claims as originally filed.

Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully submit that Claim 16 is supported by the specification, the figures, and the claims as originally filed. Reconsideration and withdrawal of the relevant rejection is respectfully.

No new matter has been introduced by these amendments. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Drawings

The drawings are objected to under 37 CFR 1.83(a) because the drawings do not show every feature of the invention as specified in the claims. Particularly, the marking of the areas of deviation that prompted the negative automatic decision regarding acceptance during the generating of the image must be shown or the features(s) canceled from the claims.

Applicants hereby submit a corrected drawing sheets in compliance with 37 C.F.R. 1.121(d). The amended drawing sheet includes all of the figures appearing on the immediate prior version of the sheet. The replacement sheet is labeled "Replacement Sheet" in the page header (as per 37 C.F.R. §1.84(c)). Consideration and entry of the Replacement Drawing Sheet for Figure 1 is respectfully requested.

Claim Objections

Claims 1 and 7 are objected to because of various informalities. Particularly, in Claim 1, line 13 and Claim 7, lines 16-17, “the areas of deviation” lacks proper antecedent basis. Further in Claim 7, “the deviation of authenticity parameters” also lacks proper antecedent basis.

Applicants herein amend Claims 1 and 7 to delete “the” before “areas of deviation” and “deviation of authenticity parameters” to provide proper antecedent basis. Reconsideration and withdrawal of the relevant claim objections is respectfully requested.

Claim Rejections Under 35 U.S.C. §103(a)

Claims 1-3, 5, 7-13, 15 and 16 are rejected under 35 U.S.C. §103(a) as being obvious over Stratigos et al., U.S. Patent No. 5,537,486 (hereinafter “Stratigos”) in view of Paraskevagos, U.S. Patent Application Publication No. 2004/0131230 A1 (hereinafter “Paraskevagos”). Claim 4 is rejected under 35 U.S.C. §103(a) as being obvious Stratigos in view of Paraskevagos, further in view of Stinson et al, U.S. Patent No. 6,695,204 (hereinafter “Stinson”). Claims 1 and 7 have been amended to include the limitations of Claim 4. Accordingly, Claim 4 is hereinabove canceled without prejudice.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Amended Claim 1 recites, *inter alia*:

“if the automatic decision regarding acceptability is negative, performing a detailed inspection of adjustable parameters in order that a preliminary decision between a direct rejection of the banknote and a final decision by a service employee may be rendered automatically.”

Amended Claim 7 recites, *inter alia*:

“a unit for adjustable parameters for performing a detailed inspection such that a preliminary decision between a direct rejection of the banknote and a final decision by a service employee may be rendered automatically.”

It is respectfully conceded in the Office Action that Stratigos does not teach if the automatic decision is negative, performing a detailed inspection of adjustable parameters, in order that a preliminary decision between a direct rejection of the bank note and a final decision by a service employee may be rendered automatically. However, it is contended that Stinson teaches rendering an automatic decision regarding acceptability of a bank note and allowing a visual inspection by a service employee, whereby, if the automatic decision is negative (either “automatically reject” or “intervention” at Col. 3, lines 54-63) a preliminary decision between a direct rejection (“automatically reject” at Col. 3, lines 54-63) of the bank note and a final decision by a service employee (“intervention criteria” at Col. 3, lines 54-63) may be rendered automatically. Applicants respectfully disagree.

Firstly, Stinson only teaches automatically rejection a check when the check meets a set of rejection criteria and displaying information about the check on the display device when the check meets a set of intervention criteria, to *permit the human operator to accept or reject the check*. That is, there is no decision whatsoever between the automatic rejection and the human operator interaction during the intervention disclosed by Stinson. That is, Stinson only teaches automatic rejection or purely manual decision by the human operator. Thus, Stinson does not teach or suggest that a preliminary decision between a direct rejection of the bank note and a final decision by a service employee may be rendered automatically as recited in amended Claims 1 and 7.

Secondly, since Stinson does not teach or suggest a preliminary decision between a direct rejection of the bank note and a final decision by a service employee may be rendered automatically, Stinson necessarily does not teach or suggest a unit for adjustable parameters for performing a detailed inspection as further recited in amended Claim 7.

Thirdly, it is further contended in the Office Action that it is well known in the art to adjust the brightness and contrast in a scanned image to improve the detectability of image patterns or to adjust operation parameters according to the varying operation of the device.

Applicants understand this to be directed at performing a detailed inspection of adjustable parameters of the claimed invention.

For argument sakes, if adjusting the brightness and contrast in a scanned image or to adjust operation parameters according to the varying operation of the device is considered performing a detailed inspection of adjustable parameters, Stinson clearly does not teach or suggest this limitation of the claimed invention.

Official Notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. (MPEP 2144.03(A.)) While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 C.F.R. 1.113. *Id.* It would not be appropriate to take official notice of facts without citing prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well known. *Id.* For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21 and MPEP 2144.03(A.).

The pertinent art as defined by the Stratigos and Paraskevagos classification is taken to be image analysis and more particularly, reading of bank checks and paper money, respectively. The pertinent art of Stinson includes registers, and more particularly, banking systems. Applicants respectfully submit that no citation to a reference, recognized as the standard in image analysis or registers, especially in the reading of bank checks, paper money and banking systems has been offered in the present office action to support the Examiner's contention that it is well known in the art to adjust the brightness and contrast in a scanned image to improve the detectability of image patterns or to adjust operation parameters according to the varying operation of the device.

As discussed above, the Examiner concedes that Stratigos and Paraskevagos do not teach if the automatic decision regarding acceptability is negative, performing a detailed inspection of adjustable parameters in order that a preliminary decision between a direct rejection of the banknote and a final decision by a service employee may be rendered automatically as claimed in amended Claims 1 and 7. (See, Page 7 of the Office Action.) Stinson also does not teach these limitations of amended Claims 1 and 7 as further discussed above. Therefore, these three

cited references do not establish a standard in image analysis or registers, particularly in the reading of bank checks, paper money and banking systems. Consequently, the Examiner is respectfully requested to provide documentary evidence to support the assertion that it is "well known in the art" that adjusting the brightness and contrast in a scanned image to improve the detectability of image patterns or to adjust operation parameters according to the varying operation of the device, in the pertinent art of image analysis and registers, particularly in the reading of bank checks, paper money and banking systems.

Furthermore, since Stratigos and Paraskevagos relate to the pertinent art and do not teach or suggest, and in fact are silent to if the automatic decision regarding acceptability is negative, performing a detailed inspection of adjustable parameters in order that a preliminary decision between a direct rejection of the banknote and a final decision by a service employee may be rendered automat, Applicants respectfully submit that Examiner's assertion is not capable of *instant and unquestionable* demonstration as being well known. (MPEP 2144.03(A.)) Therefore, Applicant respectfully submits that it is not well known in the art of image analysis in the reading of bank checks and paper currency, to adjust the brightness and contrast in a scanned image to improve the detectability of image patterns or to adjust operation parameters according to the varying operation of the device. Accordingly, prime facie obviousness does not exist regarding amended Claims 1 and 7 with respect to Stratigos, Paraskevagos and Stinson.

As discussed above, Stratigos, Paraskevagos and Stinson, alone or in combination, *do not teach or suggest all of the limitations* of at least amended Claims 1 and 7. Thus, *prima facie* obviousness does not exist regarding amended Claims 1 and 7 with respect to Stratigos, Paraskevagos and Stinson.

Finally, Applicants respectfully contend that there exists *no suggestion or motivation to combine* the references to teach the claimed invention.

To rely on a reference under 35 U.S.C. 103, it must be analogous art. (MPEP 2141.01(a)) In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor, or if not, then be reasonably pertinent to the particular problem with which the invention was concerned. (*Id.*)

Stratigos describes a high speed document verification system in which the validity of the document is checked by the differential response of an optical scanner to subtle variations in the

reflectivity of a pattern printed on the check, the variations being invisible to the human eye. (Col. 1, lines 45-62.) That is, Stratigos is directed to verifying an authentication marking such as a pattern or an icon, which is generally not or only barely visible by a human eye. (Col. 4, lines 29-33.) The present invention is directed to the acceptance of banknotes in automatic vending machines in order to provide proper and quick payment in fields of ticketing and related machines. Stratigos requires a totally different action by the service employee in contrast the present invention and is not *reasonably pertinent to the particular problem with which the claimed invention is concerned*. A further decision of the service employee would only make sense if the service employee has notice from the deviation, so it makes no sense to request a decision from a service employee if, for example, the feature is not or only barely visible to the human eye. Additionally, applying Stratigos to a field of ticketing or related machine (like an automatic vending machine), where invisible or barely visible features are used for a service employee to make a decision, would be contrary to the present invention. Therefore, in Stratigos, there exists no *suggestion or incentive that would have motivated the skilled artisan to modify or combine the references* to teach the claimed invention.

Stinson relates to registers and banking systems as discussed above. Therefore, Stinson is in a different technical field than the present invention. Therefore, there exists no *suggestion or incentive that would have motivated the skilled artisan to modify or combine the references* to teach the claimed invention.

Furthermore, Column 3, lines 54 through 63 in Stinson is cited in the Office Action as disclosing a preliminary decision between a direct rejection of the bank note and a final decision by a service employee may be rendered automatically. Applicants respectfully disagree. This cite of Stinson relates to only the intervention step of the human operator, as a final decision is made by a human if a set of criteria are met. However, these criteria are described in more detail in the preferred embodiment of Stinson. The primary objective of Stinson is to identify the customer. The intervention criteria is based in this objective and is focused around data specific to the customer. (See, for example, Col. 10, lines 43-57.) That is, the whole description of the preferred embodiment of Stinson teaches the importance of the customer's identification. Applicants respectfully submit that Stinson *is not in the field of Applicants' endeavor and is not reasonably pertinent to the particular problem with which the claimed invention is concerned*.

Therefore, there further exists no *suggestion or incentive that would have motivated the skilled artisan to modify or combine the references* to teach the claimed invention.

Since Stratigos, Paraskevagos and Stinson fail to teach or suggest all of the limitations of amended Claims 1 and 7, one of ordinary skill at the time of Applicant's invention would not have a *motivation to modify or combine the references, or a reasonable likelihood of success in forming the claimed invention* by the Examiner's suggestion of modifying or combining the reference. Thus, here again, *prima facie* obviousness does not exist. *Id.*

Thus, the requirements of *prime facie* obviousness are not met by the Examiner's suggestion to combine Stratigos, Paraskevagos and Stinson. Applicants respectfully submit that amended Claims 1 and 7 are not further rejected or objected and are allowable. As Claims 2, 3, 5, 8-13, 15 and 16 depend from allowable Claims 1 and 7, they are thus correspondingly allowable. Reconsideration and allowance of Claims 1-3, 5, 7-13, 15 and 16 is respectfully requested.

Conclusion

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

Application No. 10/077,221
Response dated: September 26, 2005
Reply to Office action of May 26, 2005

In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicants' attorney hereby authorizes that such fee be charged to Deposit Account No. 06-1130.

Respectfully submitted,

CANTOR COLBURN LLP

By: Amy Bizon-Copp
Amy Bizon-Copp
Reg. No. 53,993
CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002
Telephone (860) 286-2929
Facsimile (860) 286-0115

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Amendment to the Drawings

Please amend Figure 1 to indicate marking of the areas of deviation as recited in Claims 1 and 7.

No new matter has been added. Clean replacement sheets are provided herewith.